

ESTTA Tracking number: **ESTTA542176**

Filing date: **06/06/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Showa Glove Co.		
Entity	Corporation	Citizenship	Japan
Address	565 Tohori Himeji Hyogo, 670 0802 JAPAN		

Attorney information	Katrina M. Quicker Ballard Spahr LLP 999 Peachtree Street Suite 1000 Atlanta, GA 30309 UNITED STATES hilleyl@ballardspahr.com, quickerk@ballardspahr.com, folmarw@ballardspahr.com, grierj@ballardspahr.com, odonnellm@ballardspahr.com Phone:678.420.9300		
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Applicant Information

Application No	85631961	Publication date	05/07/2013
Opposition Filing Date	06/06/2013	Opposition Period Ends	06/06/2013
Applicant	Global Glove and Safety Manufacturing, Inc. 17700 113th Avenue North Dayton, MN 55369 UNITED STATES		

Goods/Services Affected by Opposition

Class 021. First Use: 2012/01/27 First Use In Commerce: 2012/02/01 All goods and services in the class are opposed, namely: Disposable plastic gloves for general use
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1701906	Application Date	09/06/1991
Registration Date	07/21/1992	Foreign Priority Date	NONE
Word Mark	N-DEX		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 025. First use: First Use: 1990/05/00 First Use In Commerce: 1990/07/00 gloves		
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U.S. Registration No.	2691302	Application Date	08/13/1999
Registration Date	02/25/2003	Foreign Priority Date	NONE
Word Mark	CLEAN-DEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1998/01/31 First Use In Commerce: 1998/01/31 PROTECTIVE GLOVES, NAMELY, NITRILE RUBBER GLOVES FOR INDUSTRIAL USE		

U.S. Registration No.	2729032	Application Date	08/28/2002
Registration Date	06/24/2003	Foreign Priority Date	NONE
Word Mark	N-DEX FREE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2002/01/00 First Use In Commerce: 2002/03/00 protective gloves for industrial use Class 010. First use: First Use: 2002/01/00 First Use In Commerce: 2002/03/00 protective gloves for medical and healthcare use		

U.S. Registration No.	3109845	Application Date	11/17/2004
Registration Date	06/27/2006	Foreign Priority Date	NONE
Word Mark	NITRIDEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/02/16 First Use In Commerce: 2006/03/08 gloves, namely, protective nitrile gloves for cleanroom and laboratory use		

U.S. Registration No.	4278853	Application Date	05/18/2012
Registration Date	01/22/2013	Foreign Priority Date	NONE
Word Mark	N-DEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1990/05/00 First Use In Commerce: 1990/07/00 Protective gloves for industrial use		

	Class 010. First use: First Use: 1990/05/00 First Use In Commerce: 1990/07/00 Gloves for medical use Class 021. First use: First Use: 1990/05/00 First Use In Commerce: 1990/07/00 Gloves for household purposes; Household gloves for general use
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Attachments	Notice of Opposition w Exhibit A.pdf(440780 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/W. Folmar/
Name	Winston Folmar
Date	06/06/2013

**ATTORNEY DOCKET NO.: 26117.5003
NOTICE OF OPPOSITION TO SERIAL NO. 85631961
OPPOSED MARK: SYNT-DEX**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 85631961
Filed: May 22, 2012
For the Mark: SYNT-DEX
Published in the Official Gazette on: May 7, 2013

Showa Glove Co.,

Opposer,

v.

Global Glove and Safety Manufacturing, Inc.

Applicant.

Opposition No.: _____

NOTICE OF OPPOSITION

Opposer, Showa Glove Co., believes that it will be damaged by registration of the mark SYNT-DEX as shown in the above-identified application, and hereby opposes the same pursuant to Section 43 of the Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1125.

As grounds for its opposition, Opposer alleges as follows:

1. Opposer Showa Glove Co., is a Japanese corporation, with its principal place of business at 565 Tohori, Himeji Hyogo, 670 0802, Japan.
2. Since 1954, Opposer, by itself and through its licensees, has continuously been and is in the business of manufacturing and selling gloves with latex rubber coatings for wet and dry grip; nitrile coatings for chemical, cut, and abrasion resistance; breathable polyurethane for comfort and details tasks; and PVC for chemical and liquid protection.

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3. Opposer owns a worldwide portfolio of trademark registrations including its family of “DEX” trademarks in the United States (hereinafter collectively referred to as “DEX Marks”) as follows:

- a. U.S. Registration No. 4278853 for the mark N-DEX for “protective gloves for industrial use” in Class 09, “gloves for medical use” in Class 10, and “gloves for household purposes; household gloves for general use” in Class 21, with a date of first use in commerce of July 1990;
- b. U.S. Registration No. 1701906 for the mark N-DEX for “gloves” in Class 25, with a date of first use in commerce of July 1990;
- c. U.S. Registration No. 2729032 for the mark N-DEX FREE for “protective gloves for industrial use” in Class 09 and “protective gloves for medical and healthcare use” in Class 10, with a date of first use in commerce of March 2002 in Classes 09 and 10;
- d. U.S. Registration No. 3109845 for the mark NITRIDEX for “gloves, namely, protective nitrile gloves for cleanroom and laboratory use” in Class 09, with a date of first use in commerce of March 8, 2006; and
- e. U.S. Registration No. 2691302 for the mark CLEAN-DEX for “protective gloves, namely, nitrile rubber gloves for industrial use” in Class 09, with a date of first use in commerce of January 31, 1998.

See Exhibit A.

4. Opposer, by itself and through its licensees, has used the DEX Marks, in some form or fashion, continuously in United States commerce since at least as early as July 1990.

5. Opposer, by itself and through its licensees, over the years has made large investments in both time and resources to build the DEX Marks and overall brand. Opposer’s

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DEX Marks have gained world-wide public recognition and acceptance as unmistakable identifiers of Opposer and Opposer's goods.

6. Upon information and belief, Applicant is a Minnesota corporation with a principal place of business located at 17700 113th Avenue North, Dayton, Minnesota 55369.

7. Applicant filed its application for SYNT-DEX, Application Serial No. 85631961, pursuant to Section 1(a) of the Trademark Act on May 22, 2012 for "disposable plastic gloves for general use" in Class 21, claiming a date of first use anywhere to be January 27, 2012.

8. At the time Applicant filed its SYNT-DEX application, it was involved in a separate opposition proceeding (Opposition No. 91200528), initiated by Opposer, based on Applicant's closely related SYNDEX Application (Serial No. 85142931) (the "SYNDEX Application").

9. Applicant filed the SYNDEX Application, on October 1, 2010, claiming a bona fide intent-to-use the mark in commerce for "disposable plastic gloves for general use" in Class 21. Applicant's SYNDEX Application published on March 15, 2011.

10. In response to that publication, on July 6, 2011, Opposer filed a Notice of Opposition (Opposition No. 91200528) opposing the registration of Applicant's SYNDEX mark (the "SYNDEX Opposition"). Like the instant Notice, the SYNDEX Opposition was based on Opposer's family of DEX Marks, including the N-DEX, N-DEX FREE, NITRINDEX, and CLEAN-DEX marks.

11. After Opposer served discovery requests in the SYNDEX Opposition, counsel for Applicant contacted counsel for Opposer by telephone. In particular, during that call on January 11, 2012, counsel for Applicant indicated that (1) Applicant would abandon its application for SYNDEX, (2) Applicant would adopt a new mark, (3) counsel for Applicant would review a list of current Opposer trademarks before Applicant proceeded with the adoption of new mark, and (4) Applicant would seek Opposer's thoughts on the new mark to confirm it would not be perceived as confusingly similar to Opposer's existing marks.

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OPPOSED MARK: SYNT-DEX

12. The next day, on January 12, 2012, counsel for Opposer sent counsel for Applicant the list of Opposer's trademarks.

13. Counsel for Opposer followed up to inquire about the status of the review by counsel for Applicant on February 10, 2012. On that day, counsel for Applicant confirmed that it was withdrawing the application for SYNDEX.

14. Then on May 3, 2012, counsel for Opposer sent counsel for Applicant another email asking about the progress of Applicant's review and withdrawal of its SYNDEX application.

15. On June 19, 2012, Applicant expressly abandoned its SYNDEX Application. Subsequently, on June 25, 2012, the Trademark Trial and Appeal Board entered a judgment against Applicant, sustaining Opposer's SYNDEX Opposition and refusing registration of Applicant's SYNDEX mark.

16. Importantly, Applicant is aware of Opposer's DEX Marks and overall brand, and in particular, Opposer's N-DEX Mark. In fact, Applicant's current President, Craig Wagner, once served as the Global Marketing Manager for Tillotson Corporation aka Best Manufacturing Company, now called Showa Best Glove, Inc. - Opposer's wholly-owned United States subsidiary and exclusive licensee. Moreover, during the time that Mr. Wagner served as the Global Marketing Manager, Opposer's N-DEX branded gloves were one of the company's most popular brands of gloves.

17. Furthermore, as explained above, at the time Applicant filed the SYNT-DEX application, it was involved in an opposition proceeding with Opposer related to Applicant's now-withdrawn SYNDEX application.

18. Opposer, by itself and through its licensees, first used each of its N-DEX, N-DEX FREE, NITRIDEX, and CLEAN-DEX marks in commerce more than five years prior to the Applicant's first use of the mark anywhere .

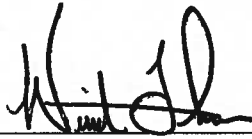
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OPPOSED MARK: SYNT-DEX

19. Like the aforementioned SYNDEX application (Serial No. 85142931) that was the subject of the SYNDEX Opposition, Applicant's future use of SYNT-DEX is likely to cause confusion with Opposer's family of "DEX" marks for its similar glove products.

20. Therefore, the application for the trademark "SYNT-DEX," Serial No. 85631961 should be rejected and refused pursuant to Lanham Act, §2(d).

WHEREFORE, Opposer prays that application Serial No. 85631961 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,



Katrina M. Quicker
Winston Folmar
Jason P. Grier
Attorneys for Opposer

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ATTORNEY DOCKET NO.: 26117.5003
NOTICE OF OPPOSITION TO SERIAL NO. 85631961
OPPOSED MARK: SYNT-DEX

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 85631961
Filed: May 22, 2012
For the Mark: SYNT-DEX
Published in the Official Gazette on: May 7, 2013

Showa Glove Co.,

Opposer,

v.

Global Glove and Safety Manufacturing, Inc.

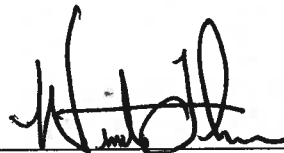
Applicant.

Opposition No.: _____

CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of June, 2013, I served the foregoing Notice of
Opposition via First Class Mail and email on the following attorney for the applicant:

William C. Peper
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EXHIBIT
A



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N-DEX

**Word Mark
Goods and
Services**

N-DEX

IC 009. US 021 023 026 036 038. G & S: Protective gloves for industrial use. FIRST USE: 19900500. FIRST USE IN COMMERCE: 19900700

IC 010. US 026 039 044. G & S: Gloves for medical use. FIRST USE: 19900500. FIRST USE IN COMMERCE: 19900700

IC 021. US 002 013 023 029 030 033 040 050. G & S: Gloves for household purposes; Household gloves for general use. FIRST USE: 19900500. FIRST USE IN COMMERCE: 19900700

**Standard
Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 85629273**Filing Date** May 18, 2012**Current Basis** 1A**Original Filing
Basis** 1A**Published for
Opposition** November 6, 2012**Registration
Number** 4278853**Registration Date** January 22, 2013**Owner** (REGISTRANT) Showa Glove Co. CORPORATION JAPAN 565 Tohori HIMEJI HYOGO JAPAN 6700802**Attorney of Record** Katrina M. Quicker

Prior Registrations 1701906;2691302;2729032;AND OTHERS

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Word Mark	N-DEX
Goods and Services	IC 025. US 039. G & S: gloves. FIRST USE: 19900500. FIRST USE IN COMMERCE: 19900700
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	74201136
Filing Date	September 6, 1991
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 28, 1992
Registration Number	1701906
Registration Date	July 21, 1992
Owner	(REGISTRANT) Tillotson Corporation AKA Best Manufacturing Co. CORPORATION MASSACHUSETTS 89 Commercial Wharf Boston MASSACHUSETTS 02110 (LAST LISTED OWNER) SHOWA GLOVE CO. CORPORATION JAPAN 565 TOHORI HIMEJI HYOGO JAPAN 670 0802
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Katrina M. Quicker
Description of Mark	Color is not claimed as a feature of the mark.
Type of Mark	TRADEMARK

Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20120525.
Renewal 2ND RENEWAL 20120525
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Typed Drawing

Word Mark	N-DEX FREE
Goods and Services	IC 009. US 021 023 026 036 038. G & S: protective gloves for industrial use. FIRST USE: 20020100. FIRST USE IN COMMERCE: 20020300
	IC 010. US 026 039 044. G & S: protective gloves for medical and healthcare use. FIRST USE: 20020100. FIRST USE IN COMMERCE: 20020300
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76444546
Filing Date	August 28, 2002
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 1, 2003
Registration Number	2729032
Registration Date	June 24, 2003
Owner	(REGISTRANT) TILLOTSON CORPORATION AKA Best Manufacturing Co. CORPORATION MASSACHUSETTS 89 Commercial Wharf Boston MASSACHUSETTS 02110
	(LAST LISTED OWNER) SHOWA GLOVE CO. CORPORATION JAPAN 565 TOHORI HIMEJI HYOGO JAPAN 670 0802
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Katrina M. Quicker
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
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Record 1 out of 1[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*(Use the "Back" button of the Internet Browser to return to TESS)***NITRIDEX****Word Mark** NITRIDEX**Goods and Services** IC 009. US 021 023 026 036 038. G & S: gloves, namely, protective nitrile gloves for cleanroom and laboratory use. FIRST USE: 20060216. FIRST USE IN COMMERCE: 20060308**Standard Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 76620954**Filing Date** November 17, 2004**Current Basis** 1A**Original Filing Basis** 1B**Published for Opposition** October 11, 2005**Registration Number** 3109845**Registration Date** June 27, 2006**Owner** (REGISTRANT) TILLOTSON CORPORATION AKA Best Manufacturing Co. CORPORATION MASSACHUSETTS 89 Commercial Wharf Boston MASSACHUSETTS 02110

(LAST LISTED OWNER) SHOWA GLOVE CO. CORPORATION JAPAN 565 TOHORI HIMEJI HYOGO JAPAN 670 0802

Assignment Recorded ASSIGNMENT RECORDED**Attorney of Record** Katrina M. Quicker**Type of Mark** TRADEMARK**Register** PRINCIPAL**Affidavit Text** SECT 15. SECT 8 (6-YR).**Live/Dead Indicator** LIVE

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Typed Drawing

Word Mark	CLEAN-DEX
Goods and Services	IC 009. US 021 023 026 036 038. G & S: PROTECTIVE GLOVES, NAMELY, NITRILE RUBBER GLOVES FOR INDUSTRIAL USE. FIRST USE: 19980131. FIRST USE IN COMMERCE: 19980131
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75776024
Filing Date	August 13, 1999
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	May 8, 2001
Registration Number	2691302
Registration Date	February 25, 2003
Owner	(REGISTRANT) Tillotson Corporation AKA Best Manufacturing Company CORPORATION MASSACHUSETTS 89 Commercial Wharf Boston MASSACHUSETTS 02110
	(LAST LISTED OWNER) SHOWA GLOVE CO. CORPORATION JAPAN 565 TOHORI HIMEJI HYOGO JAPAN 670 0802
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Katrina M. Quicker
Prior Registrations	1701906
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130126.
Renewal	1ST RENEWAL 20130126

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